REMARKS/ARGUMENTS

Status of the Application

In the Office Action, claims 2, 6, and 31 were rejected. In this Response, claim 6 was amended to correct grammatical mistakes. No new matter was added.

Rejections Under 35 U.S.C. § 112, 2nd Paragraph

Claims 2 and 6 were rejected under 35 U.S.C. § 112, 2nd paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Applicants have amended claim 6 to delete the extraneous "and" recited in the claim, as suggested by the Examiner, and to clarify that the exogenous DNA fragment can encode dhaB1, dhaB2, and dhaB3 or dhaB1, dhaB2, dhaB3, and dhaT. Claim 2 does not contain an extraneous "and." Applicants thus respectfully submit that the rejections under 35 U.S.C. § 112, 2nd paragraph, have been obviated.

Non-Statutory Double Patenting Rejections

Claims 2, 6, and 31 were rejected under the judicially created non-statutory double patenting doctrine.

Applicants are uncertain as to their ability to file a terminal disclaimer to the present application to overcome the non-statutory double patenting rejections. Specifically, the present application is subject to assignment to E.I. du Pont de Nemours and Company ("DuPont"). U.S. Patent No. 6,013,494 is assigned to DuPont *and* Genencor International ("Genencor"). Applicants interpret 37 C.F.R. § 321(c) to state that DuPont is a common assignee of Nakamura et al. and the present application. Consequently, Applicants believe that they can file a terminal disclaimer in this case and will do so with the Examiner's approval.

Other factors further support Applicant's conclusion. For example, filing a terminal disclaimer in no way affects Genencor's rights because Genencor has no interest in the present application. Threat of harassment from multiple assignees is not an issue because DuPont would have to be voluntarily involved with any litigation involving Nakamura et al. and/or a patent issuing from the present application. *See Waterman v. MacKenzie*, 138 U.S. 252, 255-56 (1891) (assignees owning undivided

parts of a patent must bring infringement suits jointly); *Ethicon, Inc. v. United States Surgical Corp.*, 135 F.3d 1456, 1468, 45 USPQ2d 1545, 1554 (Fed. Cir. 1998) ("as a matter of substantive patent law, all co-owners must ordinarily consent to join as plaintiffs in an infringement suit"). Further, Nakamura et al. and the present application have at least one common inventor.

Summary

In order to expedite disposition of this case, the Examiner is invited to contact Applicants' representative at the telephone number below to resolve any remaining issues. Should there be a fee due which is not accounted for, please charge such fee to Deposit Account No. 04-1928 (E.I. du Pont de Nemours and Company).

Respectfully submitted,

By: _____

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